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Date: 7/21/06By: Patti Hespell
Patti HespellMAIL STOP AFIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Patent Application of Charles A. Eldering.

Conf. No.: 8089 : Group Art Unit: 2623
Appln. No.: 09/742,852 : Examiner: Sheleheda, James R.
Filing Date: 21 December 2000 : Attorney Docket No.: T721-19
Title: System for Rescheduling and Inserting Advertisements.

Request for Pre-Appeal Brief Conference

Applicant(s) request(s) review of the final rejection in the above-identified application, under the Pre-Appeal Brief Conference Program published on July 12, 2005. No amendments are being filed with this request.

- ☒ The review is requested for the reason(s) stated on the attached sheet(s).
☒ Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences is filed herewith.

Date: 7/21/06

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Application No. 09/742,852

STATEMENT IN SUPPORT OF REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Presently, claims 4-6, 55-56, 59-60, 75, 78-79 and 90-91 are pending in the application. This paper is being filed in support of the Request for Pre-Appeal Brief Conference submitted herewith. Details of the Examiner's rejections may be found in the Non-Final Office Action dated March 24, 2006 ("Non-Final Rejection") and the Examiner's Final Office Action dated August 5, 2005 ("Final Rejection"). Discussion of the prior art references and the pending claims may be found in Applicants' Amendment Accompanying RCE, filed January 31, 2006 ("RCE Amendment") and Applicants' Amendment, filed March 2, 2005 ("Amendment"), both of which are incorporated herein by reference.

No Prima Facie Obviousness

Even though the Examiner has not established a *prima facie* case of obviousness, the Examiner has not withdrawn the rejection of claims 4-6, 55-56, 59-60, 75, 78-79 and 90-91 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,698,020 to Zigmond *et al.* ("Zigmond") in view of U.S. Patent Publication No. 2003/0200128 A1 Doherty ("Doherty"). The Examiner's reasons for this rejection may be found at pages 2-4 of the Non-Final Rejection and are also summarized at page 6 of Applicants' RCE Amendment.

1. There Is No Suggestion or Motivation to Modify the References

The Examiner can satisfy the burden of *prima facie* obviousness only by showing an objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art, would lead that individual to combine the relevant teachings of the references in the manner suggested by the Examiner. *See In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1998). The mere fact that the prior art could be modified in the manner proposed by the Examiner, does not make the modification obvious unless the prior art suggests the desirability of the modification. *See Ex Parte Dussaud*, 7 USPQ2d 1818, 1820 (Bd. Pat. App. & Interf. 1988). *See* MPEP 2143.01(I).

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The Examiner has failed to point to an objective teaching in Zigmond, Doherty or in the knowledge generally available to one of ordinary skill in the art that suggests the desirability of combining these references (RCE Amendment, pages 9-10). The Examiner continues to argue that motivation is provided by Doherty's ability to "compile and prepare advertisements in advance to eliminate any possible delay" (Non-Final Rejection, pages 11-12). Even if such a teaching is found in Doherty, one skilled in the art would not necessarily think to add a schedule and a modification thereof (according to program content) as taught by Doherty to Zigmond's system. As discussed in Applicants' RCE Amendment, Zigmond's system already has the ability to select the desired advertisement(s) "on demand", thereby obviating the need for a modifiable schedule or queue as suggested by the Examiner. Merely pointing out the existence of particular teachings in one reference is not sufficient to establish that there would be a motivation to combine that reference with another. The burden is on the Examiner to provide a convincing line of reasoning, based on knowledge generally available to one of ordinary skill in the art, established scientific principles or legal precedent, that there would have been a motivation to combine Zigmond and Doherty. *See* MPEP 2144. Accordingly, the proposed combination of Zigmond and Doherty is improper.

2. The Proposed Combination Does Not Teach or Suggest All Claim Elements

When making a rejection under 35 U.S.C. § 103, the prior art references, when combined, must teach or suggest all of the claim limitations. *See* MPEP 2143.03.

Initially, Applicants disagree with the Examiner's assertion at page 9 of the Non-Final Rejection that Applicants have argued against the obviousness rejection by attacking the references individually. Rather, Applicants have repeatedly pointed out that the references do not teach or suggest the features as contended by the Examiner, and, therefore, cannot possibly teach or suggest such features when combined.

Applicants also disagree with the Examiner's continued assertion that the combination of Zigmond and Doherty teaches the modification of an order, schedule or queue according to the displayed program content (Non-Final Rejection, pages 10-11), as recited in independent claim 4.

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For the reasons discussed at pages 6-8 and 10-11 of Applicants' RCE Amendment, Applicants disagree with the Examiner's reading of Doherty. In particular, Doherty does not teach that the schedule discussed therein is altered *based upon* the user's interactions. Rather, Doherty's schedule is altered *in response to* a user interaction. Even though the Examiner relies on Zigmond for the teaching of altering the schedule according to program content, such a teaching does not make up for the deficiencies of Doherty's schedule, since Doherty does not teach or suggest that the new or altered schedule is in any manner based on or modified according to the actual user interaction. Thus, Doherty's schedule, even accounting for Zigmond's teachings, is not reordered or modified according to program content displayed as a result of the detected change, as recited in independent claim 4.

Furthermore, even if the references are combined as argued by the Examiner, such that Zigmond's teaching of "selecting advertisements based upon the current viewed program" is sufficient to satisfy the noted deficiencies of Doherty's schedule, such a combination still lacks a teaching of modifying "the order in which the unscheduled advertisements are to be inserted according to program content displayed as a result of the detected change." Stated differently, the fact that Zigmond may teach selecting advertisements based on currently viewed programming does not mean that the resulting *combination* of Zigmond and Doherty teaches an ordered list or queue that is reordered according to the different program content. Zigmond simply does not contemplate the use of a schedule, ordered list or queue. Thus, Zigmond itself cannot be relied on to teach reordering a queue, and certainly not to reorder a queue according to different program content. As such, even if Doherty's queue were incorporated into Zigmond's system, it cannot be inferred from such a combination that the included queue will be reordered at all, let alone according to program content. As such, the Examiner is simply not entitled to assume that such a modification will occur nor use improper hindsight to contend that the resulting combination would include this feature. Simply put, there is no suggestion of a queue reordered according to program content in a combination of Zigmond and Doherty. Accordingly, the Examiner has still not pointed to any individual or combined teaching that suggests modifying "the order in which the unscheduled advertisements are to be inserted

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according to program content displayed as a result of the detected change," as recited in independent claim 4.

Applicants respectfully submit that the combination of Zigmond and Doherty is thus improper since the Examiner has not pointed to an objective teaching which suggests the motivation to combine them. Even assuming the references were properly combinable, which they are not, all features of the claims would still not be taught by the combination. Therefore, the Examiner has not met the burden of *prima facie* obviousness. Accordingly, for the reasons detailed herein as well as in Applicants' Amendment and RCE Amendment, independent claims 4 and 90, and all claims dependent thereon, are allowable over the combination of Zigmond and Doherty.

Applicants respectfully submit that the Examiner's rejections have been previously overcome, and that the application, including claims 4-6, 55-56, 59-60, 75, 78-79 and 90-91, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and a Notice of Allowance are respectfully requested.